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10/761,139	01/20/2004	Thomas R. Gumz	303606.3000-100	8821

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05/29/2007

EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,139

Applicant(s)

GUMZ ET AL.

Examiner

James H. Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to an amendment filed 03/12/2007 with a priority date of **01/20/2004**.
2. Claims 1-2, 4-12, and 14-20 are currently pending.
3. Claims 1, 6, 12, 14, and 17 are independent claims.
4. Applicants have amended Claim 14 to remove all occurrences of the term "transmission" in order to overcome the previous 35 U.S.C. 101 rejection. However, it is noted in the claim objection below that not all occurrences have been cancelled.

In addition, Applicants have requested that the Examiner hold this rejection in abeyance until a ruling in *In re Petru ACM Nuijten*, CAFC docket No. 06-1371, U.S. Patent Application Serial No. 09/211,928 has been rendered. The Examiner has checked, and as of 01/24/2006, it appears that a ruling has been made. The Examiner maintains the rejection of Claim 14 under 35 U.S.C. 101.

Claim Objections

5. Claim 14 is objected to because of the following informalities: The amended claim cancels the term "transmission" in the first part of the preamble, but fails to also cancel it in the phrase "said transmission comprising". Examiner has interpreted the claim to read "said signal comprising".
6. Claim 6: it is unclear in line 3 of Claim 6 where the "memory" resides? When the claim is read, as a whole, the memory appears to reside on a server since the

remainder of the limitations suggest that the eventual file is being "served" to a network to a receiving computer. However, if one compares this claim, as a whole, to the remaining independent claims, it seems inconsistent with them (and the invention) which has loading and executing on a client a file, whose reference is embedded in a file on a server, served by the server to the client, identified by a client and is loaded and executed from the client. The current wording seems to suggest that the file is on a server and somehow gets the executable file from the client, then executes on the client. The client sends the file to the network.

A rewording of this claim is suggested to make it consistent with the remainder of the claims.

7. Claim 19 should read: The computer program product of claim 17 ~~whereas~~ wherein said display device is associated with a client device.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 14 is directed to non-statutory subject matter. Specifically, the use of the term "transmission" in this context would not appear to be any of: interconnected mechanical and/or electromechanical components which cooperate to accomplish some function so as to constitute a machine; a tangible, physical article or object which

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enables the functionality of the instructions to be realized so as to constitute a manufacture; a series of steps or acts so as to constitute a process; nor a combination of two or more substances so as to constitute a composition of matter. Claim 14 is therefore non-statutory.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2, 4-12, and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lennox (Gareth Lennox, "Client Side Includes", copyright 02/21/2000, updated 10/10/2001, downloaded from <http://ghp.dwakn.com/contents/csi/>, 2 pages).

Note: The following commentary is provided to further elaborate on the Lennox reference, as it is rather terse. However, the Examiner believes that it either directly or implicitly discloses all of the limitations of the claims, as amended.

The Lennox reference discloses the concept and implementation of "client-side includes". Client-side includes are used in situations where "server-side includes" are not supported. Server-side includes (see example, Pg. 1) when encountered in, for example, and HTML file, cause a server (e.g., a web server) to "include" a file referenced by a "custom" tagging embedded into the HTML file by its creator, or perhaps by a dynamic process that built the page on the server. The key is that server-side includes are performed on a server, then the server sends the file to a requesting client for rendering and display, for example, on a typical web browser.

Client-side includes, on the other hand, execute on the client; the server (web) simply sends the file "as is" to the client. The client-side include is implemented as an external JavaScript file contained on the client. When a web browser loads the HTML

file containing the embedded special tag (<script>), the browser (more specifically a parser component within the browser) interprets the <script> tag, loads and executes the JavaScript code. In this case, the JavaScript code contains a series of "write" commands which cause the HTML coding and content of a "footer" to be embedded into the location where the <script> tag resided. The resulting HTML page is then rendered to the client for display. The resulting displayed HTML file contains its original content plus a customized footer (see Pages 1 and 2 and annotated side note indicators).

In regard to independent Claim 1, Lennox discloses:

- *A method for operating on a client computer for loading a markup language document* (Pg. 1; → describes a solution to implement client-side includes using JavaScript), *said method comprising the steps of:*
 - *receiving said document comprising a plurality of tags, at least one of said tags being a custom tag* (Pgs. 1-2; → web pages (e.g., a web site), containing HTML markup (which contains, for example, a footer, a header, etc. that the page creator wishes to be able to change from time-to-time and an external JavaScript file. The HTML page contains, in the case of a footer, the line <script scr="footer.js"></script> at the end of each of the HTML pages (see Pg. 1 margin annotation 1). The external JavaScript file present on the client, footer.js, contains a series of lines which, when executed, add HTML lines to the web page containing the footer information (see Pg. 1, margin annotation 2).

Note: it is assumed that browsers typically available at the time of invention, and of the Lennox reference (e.g., Internet Explorer, Netscape) were designed to parse and interpret the various HTML tags in a known fashion (e.g., recognize and properly interpret a <script> tag). The Lennox reference therefore, would have been expected to cause a browser's parser to process its <script> tags in a manner consistent with available browsers. Thus, a typical browser, upon loading an HTML file containing <script> tags would have been expected to perform,

- *parsing said document to determine if certain of said plurality is said custom tag* (as the client browser loads the page, the parser encounters the <script> tag (interpreted as a custom tag), recognizes by conventional means (in which script tags are typically interpreted by browser parsers), the <script> tag, and loads the file footer.js, which is resident on the client (note, the fact that the path, or lack thereof, accompanying the scr="footer.js" attribute would suggest that the file exists on the client)
- *inserting executable instructions into said document at a location of said custom tag, if said custom tag is present; executing said instructions; and rendering said document on a display device* (the footer.js file executes (see Pg. 1, side note 2. The JavaScript statements in this file simply print the footer HTML content into the web page at the location of the <script> tag).

In regard to dependent Claim 2, Lennox discloses:

- *said markup language is HTML* (Pgs. 1-2; → portrays tagging that is indicative of what a user would have expected to find in a typical HTML page at the time of invention, see for example, side note 1 on page 1, and paragraph below side note 1).

In regard to dependent Claim 4, Lennox discloses:

- *said document is received over the internet* (Pg. 1; → in discussions of both server and client-side includes is mentioned a server sending a page to a client typically over a network as one would expect of a client-server system).

In regard to dependent Claim 5, Lennox discloses:

- *the step of rendering further comprises using a browser* (Pg. 2; → discusses the use of a browser “getting” the footer.js file and writing its contents to the page.).

In regard to independent Claim 6, Lennox discloses:

- *A method for creating and providing a markup language document to a network* (Pg. 1; → describes a solution to implement client-side includes using JavaScript into a web document resident on a server and requested by a user), *said method comprising the steps of:*
 - *loading said document into a memory, said document containing conventional tags and at least one custom tag, said custom tag associated*

with machine-executable instructions resident on a receiving computer in communication with said network; said receiving computer identifying said custom tag and inserting said machine-executable instructions into said document at a location associated with said custom tag; and providing said document to said receiving computer over said network (Pgs. 1-2 and Note; → presuming that the memory is on a client, and clients are typically computer devices, and Lennox describes a browser running on a client device, loading a web page containing embedded <script> tags referencing JavaScript files resident on the client. The browser recognizes the <script> tag and loads and executes the referenced JavaScript file which embeds additional HTML coding (a footer) into the existing page in place of the <script> tag reference

In regard to dependent Claim 7, Lennox discloses:

- *said markup language is HTML* (Pgs. 1-2; → portrays tagging that is indicative of what a user would have expected to find in a typical HTML page at the time of invention, see for example, side note 1 on page 1, and paragraph below side note 1).

In regard to dependent Claim 8, Lennox discloses:

- *said receiving computer is a client computer* (Pgs. 1-2; → client-side include is implemented as a JavaScript file located, and executed on a client machine).

In regard to dependent Claim 9, Lennox discloses:

- *a server providing said document to said network* (Pgs. 1-2; → “the server just delivers the page as is” in the case of using a client-side include).

In regard to dependent Claim 10, Lennox discloses:

- *said network is an Internet protocol (IP) network* (Pgs. 1-2; → a client-server system implies a network, web pages are being served from servers to clients, the pages contain <script> tags which are understood by browsers on clients. Also, typical client-server systems of the type inferred by Lennox were IP networks).

In regard to dependent Claim 11, Lennox discloses:

- *said receiving computer renders said document on a display device using a browser* (Pgs. 1-2; → browser on client loads HTML page from server containing <script> tag, loads and executes JavaScript which prints additional HTML code for a footer for the page which the browser then renders and displays on the client).

In regard to Claim 12, Claim 12 merely recites an apparatus for performing the method of claim 1. Thus, Lennox discloses every limitation of Claim 12, as indicated in the above rejection for Claim 1.

In regard to Claims 14 and 15, Claims 14 and 15 merely recites a computer-readable data signal for performing the method of claims 1 and 2, respectively. Thus, Lennox discloses every limitation of Claims 14 and 15, as indicated in the above rejections for Claims 1 and 2.

In regard to dependent Claim 16, Lennox discloses:

- *said network is an Internet protocol (IP) network* (Pgs. 1-2; → a client-server system implies a network, web pages are being served from servers to clients, the pages contain <script> tags which are understood by browsers on clients. Also, typical client-server systems of the type inferred by Lennox were IP networks).

In regard to Claims 17 and 18, Claims 17 and 18 merely recite a computer program product for performing the method of claims 1 and 2, respectively. Thus, Lennox discloses every limitation of Claims 17 and 18, as indicated in the above rejection for Claims 1 and 2.

In regard to dependent Claim 19, Lennox discloses:

- *said display device is associated with a client device* (Pg. 1; → including an external JavaScript file in our (web) pages. But, we need some way of writing the HTML and not the JavaScript to the page).

In regard to dependent Claim 20, Lennox discloses:

- *said network is an Internet protocol (IP) network* (Pgs. 1-2; → a client-server system implies a network, web pages are being served from servers to clients, the pages contain <script> tags which are understood by browsers on clients. Also, typical client-server systems of the type inferred by Lennox were IP networks).

Response to Arguments

12. Applicant's arguments with respect to claims 1-2, 4-12, and 14-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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05/22/2007


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